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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/760,213 | 01/21/2004 | Kia Silverbrook | SMA03US | 1347 |
| 24011 7590 10/25/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA | | | EXAMINER MARTINEZ, CARLOS A | |
| | | | ART UNIT 2853 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/760,213 | Applicant(s) SILVERBROOK ET AL. | |
| | Examiner Carlos A. Martinez, Jr. | Art Unit 2853 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/03/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: “mechansm” is a typographical error [note: change to “mechanism”]. Appropriate correction is required
2. Claim 23 is objected to because of the following informalities: error in numbering of claims – claim 23 should be claim 22. Appropriate correction is required
3. Claims 2-21 and 23 are objected to because of the following informalities: “A cartridge as claimed in claim” is an improper dependence reference [note: change to “The cartridge as claimed in claim”]. Appropriate correction is required.
4. Claims 5-21 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims (claims 7-21 and 23) make reference to a cartridge; however, they fail to further limit the structure/elements of a cartridge because they merely relate the structure/elements of the environment (i.e. “digital processor” in claim 5; “digitized data” in claim 6; “printer” in claim 7; “print head” in claims 8-11; “drier means” in claim 12; “slitter means” in claims 13 and 14; “guillotine” in claim 15; “support structure” in claims 16 and 17; “drive means” of claim 18; “paper feed drive” in claim 19; and

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“print media feed” in claim 23) that the applicant desires to use the cartridge with or in, instead of providing further limitation to the parent claim which is structure/elements of the cartridge.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1-21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claim 1, the expression “having a digital processor and a printer arranged to receive drive signals from the digital processor” and “being arranged to be mounted removable in juxtaposition to the printer” is unclear and uncertain to the Office what is being claimed or what the applicant desires to be their claimed invention. The abstract, the title, and the preamble of the claims would suggest that the applicant is claiming as their invention a cartridge; however, as the claim (claim 1) is written, it appears that the applicant is trying to claim a digital processor and a printer as being apart of the cartridge, and/or it appears that the applicant is trying to set forth a digital processor and printer as limitations of the cartridge – which should not be the case because applicant’s specification shows that a digital processor and printer are not integrally apart of the cartridge (but are separate entities in themselves and are not necessary for a cartridge). Therefore, as the claim language is indefinite to the Office, for the purpose of examination this claim (claim 1) will be examined with respect to a cartridge.

On the other hand, as written, claim 1 could also be interpreted to be a mixture of statutory classes, and thus the statutory category of the invention that is being claimed can be said to be indistinct because the preamble of the claims – which states “A cartridge” – suggest to render the claims as directed towards an apparatus; however, as the claim language further notes, for example, “...being arranged to be mounted removably in juxtaposition to the printer...” would suggest that applicant is seeking to render the claim as being a method claim. Therefore as the statutory category of the invention being claimed is indistinct, for the purpose of examination, this claim will be interpreted as an apparatus.

Further, since claims 2-21 and 23 are dependent on a rejected parent claim they are also rejected under 35 U.S.C. 112, second paragraph.

6. Also, claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the statutory category of the invention that is being claimed is indistinct because the preamble of the claims – which states “A cartridge...” – suggest to render the claims as directed towards an apparatus; however, as the claim language further notes “...removably mounted to a digital photofinishing system in which the digital processor is arranged to receive digitized data...and to process the data the data in a manner to generate a printer drive signal...the printer...being arranged to process the drive signal and effect page-width printing...” would suggest that applicant is seeking to render the claim as being a method claim.

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Therefore as the statutory category of the invention being claimed is indistinct, for the purpose of examination, this claim will be interpreted as an apparatus.

7. Also, claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the statutory category of the invention that is being claimed is indistinct because the preamble of the claims – which states “A cartridge...” – suggest to render the claims as directed towards an apparatus; however, as the claim language further notes “...digitized data is input...and processed as JPEG files” would suggest that applicant is seeking to render the claim as being a method claim.

Therefore as the statutory category of the invention being claimed is indistinct, for the purpose of examination, this claim will be interpreted as an apparatus.

8. Also, claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, the statutory category of the invention that is being claimed is indistinct because the preamble of the claims – which states “A cartridge...” – suggest to render the claims as directed towards an apparatus; however, as the claim language further notes “...wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media” would suggest that applicant is seeking to render the claim as being a method claim.

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Therefore as the statutory category of the invention being claimed is indistinct, for the purpose of examination, this claim will be interpreted as an apparatus.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 10/760180 (PGPub #: US20050156968). Although the conflicting claims are not identical, they are not patentably distinct from each other because the listed claims (1 and 6) together include all the structure found in claim 1 of the present invention.

- Application No. 10/760180 discloses in claim 6/1 a digital photofinishing system comprising a digital processor, a printer and means for feeding print media to the

printer from a roll of the print media; the digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, and the printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll. Claim 6/1 of 10/760180 further discloses digital photofinishing system as claimed in claim 1 and comprising: a primary cartridge that is arranged to be mounted removably in juxtaposition to the printer, the primary cartridge housing the roll of print media to be fed to the printer and incorporating means for coupling with a print media feed drive mechanism, and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 5-19, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook (US20020093569).

Silverbrook teaches cartridge (504) for a digital photofinishing system ([0001] and [0005] to [0008]) having a digital processor and a printer arranged to receive drive signals from the digital processor ([0051]; also [0061] to [0065]); the cartridge being arranged to be mounted removably in juxtaposition to the printer (refer to position of element 504 in relation to printer in Fig. 12 and Fig. 13) and comprising a source of printing fluid (548) to be delivered on demand to the printer ([0041]), and the cartridge incorporating means (538) for coupling with a print media feed drive mechanism (540, 534, and 536).

With respect to claim 2, Silverbrook discloses a digital photofinishing system ([0001] and [0005] to [0008]), a digital processor ([0051]; also [0061] to [0065]) and print media (504).

With respect to claim 3, Silverbrook discloses incorporating a replaceable roll of print media ([0060]).

With respect to claim 18, Silverbrook discloses a print media feed means (540, 534, and 536) located in the cartridge (504).

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With respect to claim 23, Silverbrook discloses wherein the print media feed means include a drive roller and a pinch roller (540, 534, and 536; also refer to Fig. 5).

With respect to claims 5-17 and 19, since a proper further limitation is not made to a cartridge. The claims (claims 5-17 and 19) are, therefore, rejected along with the claim 1 because they merely relate the intended use or the structure/elements of the environment which applicant desires to use the cartridge with or in. Nevertheless, with respect to claim 5, Silverbrook (US20020093569) discloses wherein the digital processor ([0051]; also [0061] to [0065]) is arranged to receive said digitised data from an input source selected from a scanning device, a computer disk, a digital camera output, a digital camera memory card, a digital file and an internet connection ([0057] to [0059]). With respect to claim 6, Silverbrook (US20020093569) discloses a digital processor with processing ([0051]; also [0057] to [0065]). Also, with respect to claim 6, Aichi (US20060044395) discloses digital processing with JPEG files ([0038], [0072], [0154], and [0336]). With respect to claims 7-11, Silverbrook (US20020093569) discloses at least one print head assembly (516; also [0046] to [0051]). Further, with respect to claims 7-11, Silverbrook (US6612240) discloses two-confronting spaced apart print head assemblies (element 56 of Fig. 9). With respect to claim 12, Silverbrook (US6612240) discloses a drier means (lines 47-67 of column 6). With respect to claims 13-15, Kwasny (US6554511) discloses slitter/guillotine for a printer (refer to Fig. 2; also abstract). With respect to claims 16 and 17, Silverbrook (US20020093569) discloses a support structure (902). With respect to claim 19, Silverbrook (US20020093569) discloses a paper feed drive mechanism (538).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (US20020093569), as applied to claim 19, and further in view of Enix (US4904100).

- Silverbrook fails to specifically disclose wherein a door is provided in a wall portion of the cartridge.
- Enix discloses wherein a door (64) is provided in a wall portion of the cartridge (60).
- Therefore, it would have been obvious to one having skill in the art at the time the invention was made to a cartridge, as taught by Silverbrook, wherein a door is provided in a wall portion of the cartridge, as taught by Enix, for the purpose of providing access to the internal media of a cartridge.

With respect to claim 21, since a proper further limitation is not made to a cartridge, the claim (claim 21) is, therefore, rejected along with its parent claims because it merely relates the intended use or the structure/elements of the environment which applicant desires to use the cartridge with or in.

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Allowable Subject Matter

13. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Pertinent Art/References

14. The prior art made of record and considered pertinent to applicant's disclosure. Appropriate prior art, which is nearest to the subject matter defined in the claims, is listed in the Notice of References Cited. These prior art references, such as US5799219, US6238044, and US6347864 are included because they pertain to a cartridge or subject matter/elements pertinent to a cartridge similar to those defined in the claims of the applicant.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Martinez whose telephone number is (571) 272-8349. The examiner can normally be reached on 8:30 am - 5:00 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D. MEIER can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10/15/2007


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PRIMARY EXAMINER